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SUITE 800				
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EXAMINER				
SALLARD, SHANNON S				
ART UNIT		PAPER NUMBER		
3628				
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10/06/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/767,143

Applicant(s)

CHARROPPIN, PASCAL

Examiner

SHANNON S. SALIARD

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 July 2008 has been entered.

Status of Claims

2. Applicant has amended claims 1 and 5, and cancelled claims 11 and 12. No claims have been newly added. Thus, claims 1-10 remain pending and are presented for examination.

Response to Arguments

3. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-4** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claims 1-4**, the claim language of "Device alerting to the expiration of tariffs for a franking system, comprising a random access memory (RAM) for recording postal data including...a processing unit" is vague and indefinite. It is unclear to the Examiner if the device contains a processing unit or the RAM contains a processing unit. Appropriate correction is required. For the purpose of examination, the Examiner will interpret the claim to read that the device includes a processing unit.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 5-10** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 5-10 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus that

accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). While claims 5-10 identify the apparatus as RAM, nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. To permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law. Cf., *Flook*, 437 U.S. at 593 (rejecting the respondent's assumption that "if a process application implements a principle in some specific fashion, it automatically falls within the patentable subject matter of § 101," because allowing such a result "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature."). see *Ex parte Langemyr*. Since the use of RAM is considered to be a nominal recitation of structure, and nominal recitations do not convert an otherwise non-statutory process into a statutory process, claims 5-10 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-3, 6, 7, 9, and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al [US Patent 7,103,583] in view of Dlugos et al [US 6,463,133].

As per **claims 1 and 5**, Baum et al discloses a device alerting to the expiration of tariffs for a franking system, comprising a random access memory (RAM) for recording postal data (col 4, line 63-col 5, line 10) including:

a first table of postal tariffs relative to postal products and services (col 6, lines 34-38) and a processing unit for updating these postal tariffs (col 8, lines 53-55),

wherein said RAM further comprises a second table of postal tariffs (col 7, lines 59-62; Fig. 1); and

and said processing unit comprises means for emitting to a franking system a message alerting to the expiration of tariffs when a date of application of said postal tariffs of said second table is identical to or earlier than a desired date of franking and when one of said compared postal tariffs has been changed (col 8, lines 53-62, communicating an instruction to implement a conversion when the current date falls short of the conversion date).

Although Baum et al does not explicitly disclose said processing unit comprises means for comparing said postal tariffs of the first and second tables, wherein said comparing means provides for a determination as to whether there is a change in postal tariffs being compared; Baum et al does disclose the release order number of the previous postage fee schedule (first table) is compared to the version number of the postage fee schedule to be loaded in the future (second table) (col 7, lines 45-54). Furthermore, Baum et al further discloses that the release number is the combination of a version and revision number (col 10, lines 22-24, revision number indicates that there is a change in data). While in Baum et al the release numbers of the tables are compared instead of the postal tariffs of the tables, it would have been obvious to one of ordinary skill in the art at the time of the invention to compare the postal tariffs in the tables instead of the release date for the similar reason of indicating a change in postal tariffs and to yield the predicted outcome of ensuring that the postal tariffs being utilized in the franking machine are valid and updated, as suggested by Baum et al (col 7, lines 46-48).

While Baum et al discloses emitting to a franking system a message alerting to the expiration of tariffs when a date of application of said postal tariffs of said second table is identical to or earlier than a desired date of franking and when one of said compared postal tariffs has been changed (col 8, lines 53-63), Baum et al does not disclose emitting a message to the operator of the franking system; and said device further comprises means for emitting the alert message to the operator upon a determination that there is a change in the postal tariffs, whereupon the operator

decides whether to replace the postal tariffs of the first table with the postal tariffs of the second table.

However, Dlugos et al discloses emitting to the operator of the franking system a message alerting to the expiration of tariffs (col 4, lines 32-35); and said device further comprises means for emitting the alert message to the operator upon a determination that there is a change in the postal tariffs (col 4, lines 32-35), whereupon the operator decides whether to replace the postal tariffs of the first table with the postal tariffs of the second table (col 4, lines 31-35; col 4, line 55- col 5, line 15; module "30" contains postal rate tables, and user plugs in module "30" to download new rate data into module "30"). It would have been obvious to one of ordinary skill in the art to include in the postal system of Baum et al the ability to emit to an operator that postal tariffs are expiring, and allow the operator to replace the expired tables as taught by Dlugos et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 2**, Baum et al further discloses wherein said second table of postal tariffs is loaded in the franking system at a periodicity defined by the Postal Service (col 9, lines 22-25).

As per **claim 3**, Baum et al further discloses wherein said second table of postal tariffs is loaded in the franking system from a remote resetting centre (col 3, lines 6-7).

As per **claim 6**, Baum et al further discloses wherein the new postal data are stored at the location of the current postal data when the operator has accepted the updating of these postal data (col 4, lines 12-22).

As per **claim 7**, Baum et al further discloses wherein the current postal data are stored in a blank part of the RAM, to be kept for control purposes (col 6, lines 14-17; col 7, lines 58-61).

As per **claim 9**, Baum et al discloses wherein the postal data comprise postal tariffs (col 12, lines 52-54).

As per **claim 10**, Baum et al further discloses wherein the postal data comprise postal products and services (col 12, lines 52-54).

10. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al [US Patent 7,103,583] in view of Dlugos et al [US 6,463,133] as applied to claim 1, and in further view of Thiel [US 6,321,214].

As per **claim 4**, While Baum et al and Dlugos et al disclose loading a second table of postal tariffs in the franking system (Baum et al: col 7, lines 45-54), Baum et al and Dlugos et al do not disclose wherein said second table of postal tariffs is loaded in the franking system whenever credit is reloaded. However, Thiel discloses wherein said second table of postal tariffs is loaded in the franking system whenever credit is reloaded (col 22, lines 18-25). Therefore it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the modified Baum et al to include the method disclosed by Thiel for the advantage of convenience, efficiency, and

in order to be sure the proper rates are always present on the customer system.

Furthermore, it would have been obvious to one of ordinary skill in the art to include in the postage system of the modified Baum et al the ability to load a new tariff table when credit is reloaded as taught by Thiel since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

11. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al [US Patent 7,103,583] in view of Dlugos et al [US 6,463,133] as applied to claim 5, and in further view of Eckert [US 4,516,014].

As per **claim 8**, While Baum et al and Dlugos et al disclose emission of a message alerting to the expiring of tariffs (Dlugos et al: col 4, lines 32-35), Baum et al and Dlugos et al do not disclose wherein the emission of the message alerting to the expiration of tariffs is inhibited by the operator except for the first such message after the franking system has been put into operation. However, Eckert discloses wherein emission of an alerting message is inhibited by an operator except for the first such message after the franking system has been put into operation (col 8, line 66-col 9, line 14, Examiner interprets a message to be the same as a warning light). It would have been obvious to one of ordinary skill in the art to include in the postage system of the modified Baum et al the ability to inhibit an alerting message as taught by Eckert since

the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is (571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Hand delivered responses should be brought to the Customer Service Window,
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